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EXAMINER

ZACHARIA, RAMSEY E

ART UNIT PAPER NUMBER

1773

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/978,029

Applicant(s)

YABUKI, YOSHIHARU

Examiner

Ramsey Zacharia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 12 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8 and 11 is/are rejected.
- 7) ☒ Claim(s) 6, 7, 9 and 10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/4/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11, drawn to an optical filter, classified in class 428, subclass 411.1.
 - II. Claims 12 and 13, drawn to a plasma display panel, classified in class 313, subclass 582.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because various optical filter compositions could lead to the limitations stated in claim 12. The subcombination has separate utility such as an optical filter for a lamp.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Roger Lee on 25 June 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12 and 13 are

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withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Priority

5. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 8 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claims 8 and 11 are rendered indefinite because the meaning of term L¹ is unclear ("a methine chain consisting of an add number of methines"). Claims 8 and 11 are further rendered indefinite because the meaning of formula (1) is unclear when any of a, b, and c are zero. If "a" is zero are the N and C double bonded to each other, to nothing, or something else? If "b" is zero

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are the C and N single bonded to each other, to nothing, or something else? If "c" is zero is the dye still positively charged but with no counter ion, is it neutral, or something else?

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikuhara et al. (U.S. Patent 6,515,811) in view of Jöllenbeck et al. (U.S. Patent 5,498,345).

Ikuhara et al. teach an optical filter comprising a transparent support and a filter layer wherein the filter has an absorption maximum in the wavelength region of 560 to 620 nm and 700 to 1,200 nm (column 1, lines 51-56). The filter contains a dye in the aggregate form as a dispersion (column 3, line 50-column 4, line 24). The dye is preferably a methine dye (column 4, lines 36-38). The filter layer also contains a binder polymer (column 39, lines 60-66). A second dye having An ultraviolet absorber may also be added to the filter layer (column 39, lines 24-25). The dye having an absorption maximum in the wavelength region of 560 to 620 nm is preferably a cyanine dye that reads on the dye of instant claim 11 (column 4, line 45-column 5, line 9).

While Ikuhara et al. teach that an ultraviolet absorber may be added to the filter, there reference is silent as to the structure of the absorber.

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Jöllenbeck et al. teach an ultraviolet absorber composition employed as a dispersion (column 1, lines 6-8). The composition comprises a benzotriazole that meets the limitations of formula (I) in claim 1 and a 2-hydroxybenzophenone that meets the limitations of formula (II) in claim 1 (column 1, lines 9-37). The dispersions have good stability to transportation, storage, and high temperature (column 8, lines 10-12).

One of ordinary skill in the art would be motivated to use the ultraviolet absorber composition of Jöllenbeck et al. as the ultraviolet absorber of Ikuhara et al. because it is easier to work with a material having good stability to transportation, storage, and high temperature.

Regarding claims 3 and 4, the absorption properties are material properties. Since the absorbers taught by Jöllenbeck et al. read on those of the instant invention, they should also intrinsically possess the same absorption properties.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1-5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 5 of U.S. Patent No. 6,586,057. Although

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the conflicting claims are not identical, they are not patentably distinct from each other because the definition used in U.S. Patent No. 6,586,057 for a dye in the non-aggregated form (one in which the absorption maximum of a dye differs from that in the solution by less than 40 nm - column 36, lines 60-63) overlaps the definition used in the instant application for a dye in an aggregate form (one in which the absorption maximum of a dye differs from that in the solution by 30 nm or more - page 48, lines 27-32).

Allowable Subject Matter

14. Claims 6, 7, 9, and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. Claim 8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

16. The following is a statement of reasons for the indication of allowable subject matter.

The inventions of claims 6-10 are directed to an optical filter comprising a transparent support and a filter layer containing a binder polymer and a dye in an aggregated form. An ultraviolet absorbing agent of the formula (I) though (VIII) is also present in either the filter layer or an optional layer. The filter layer has absorption maximums in each wavelength region of 750-850 nm, 851-950 nm, and 951-1,100 nm.

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Ikuhara et al. represent the closest prior art. However, Ikuhara et al. do not teach or fairly suggest a filter layer as claimed that has absorption maximums in each wavelength region of 750-850 nm, 851-950 nm, and 951-1,100 nm.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (571) 272-1518. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau, can be reached on (571) 272-1516. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ramsey Zacharia
Primary Examiner
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